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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,750	07/15/2004	Hans-Martin Dietrich	2002P00211WOUS	1048

7590 08/24/2006

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2617

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/501,750	DIETRICH ET AL.	
	Examiner	Art Unit	
	Nghi H. Ly	2617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 18-32 and 34.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attached "Response to Arguments".
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


CHARLES APPIAH
PRIMARY EXAMINER

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 07/28/06 have been fully considered but they are not persuasive.

On page 2 of applicant's remarks, applicant argues that Kingdon does not even consider the privacy issues that arise when the report of location is from the mobile station.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Havinis teaches the privacy issues that arise when the report of location is from the mobile station (see the teaching of Havinis in claims 18 and 34 in the previous Office action) and the combination of Havinis and Kingdon does indeed teach applicant's claims invention.

On page 3 of applicant's remarks, applicant further argues that Havinis and/or Kingdon fails to meet the burden required to make a prima facie case sustain a 103 rejection and the combination of Havinis/Kingdon fails to teach claim 34.

In response, Havinis teaches a method for requesting the agreement of a user of a mobile terminal of a mobile radio network to the transfer of their position data to a party requesting this position data (see Abstract), the method comprising: defining the privacy data stored in the database server at the central privacy location to assign to the

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mobile terminal at least one verification rule as to whether an agreement must be obtained on the mobile terminal side to forward the mobile terminal position to the requester (see column 7, lines 60-67), causing, by the switching center of the mobile radio network (Abstract, see "MSC"), in the case of the arrival of a request from a requester for the position of the mobile terminal in the switching center (Abstract, see "MSC" and "positioning request", also see column 2, lines 11-41 and column 3, line 56 to column 4, line 2), the database server at the central privacy location to make a check on the basis of the privacy data stored there (see column 5, lines 41-65), sending the result of the check performed at the central privacy location to the switching center, sending, by the switching center (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC"), if the result at least indicates that an agreement must be obtained (see column 5, lines 41-65), a request for an agreement to the mobile terminal, and transmitting, if the agreement is received by the switching center (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC"), the position of the mobile terminal to the requester (see column 5, lines 41-65 and column 7, lines 10-29), and Kingdon teaches providing a central privacy location comprising a database server for storing privacy data regarding the mobile terminal (see [0008], see "*VLR 16 is a database containing information about all of the MS's*" or see "*contain various subscriber information associated with a given MS*"), wherein the central privacy location constitutes a separate location from a Home Location Register for the mobile terminal (see fig.1, VLR 16 constitutes a separate location from HLR 26, and see [0008], see "*VLR*" and "*database 16*"). Therefore, the combination of Havinis

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and Kingdon does indeed teach applicant's claims 18 and 34. In addition, applicant's attention is directed to the teaching of Havinis and Kingdon in claims 18 and 34 in the previous Office action.

On page 3 of applicant's remarks, applicant further argues that Koch or the combination of Havinis/Kingdon/Koch fails to teach claim 28.

In response, the combination of Havinis and Kingdon teaches a claim 18. However, the combination of Havinis and Kingdon does not specifically disclose the database server is arranged in an SCP (Service Control Point). Koch teaches the database server is arranged in an SCP (Service Control Point) (see column 3, line 64 to column 4, line 1). Therefore, the combination of Havinis, Kingdon and Koch teaches a claim 28. In addition, applicant's attention is directed to the teaching of Havinis, Kingdon and Koch in claim 28 in the previous Office action.

For the above reasons, the examiner believes that the rejections to claims are proper.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly



CHARLES APPIAH
PRIMARY EXAMINER